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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/020,122 02/06/98 KIRKLIN

F 980106

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KAARDAL & ASSOCIATES
ATTN: IVAR M KAARDAL
3500 South First Ave.
Circle-Suite 250
SIOUX FALLS SD 57105-5807

EXAMINER

PATEL, J	
ART UNIT	PAPER NUMBER

2164

DATE MAILED:

09/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/020,122

Applicant(s)

Kirklin et al.

Examiner

Jagdish Patel

Art Unit

2164



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 13, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15, 26, 27, and 31-39 is/are allowed.
- 6) ☒ Claim(s) 16-25, 28, and 40-57 is/are rejected.
- 7) ☒ Claim(s) 29 and 30 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Response to Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/22/01 has been entered.

Note: In prior office action dated 3/13/01, claims 1-57 have been allowed. However, upon further consideration, certain ~~claims~~ claims have been rejected on the basis of newly found prior art. Rejection of these claims have been discussed in the following paragraphs.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 21, 28 and 40-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites limitation "the identity of the product item identity transmitted to said portable station" in lines 5 and 6. There is insufficient antecedent basis for this limitation in the claim.

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Claim 28 recites "one of said person movement instructions and a product item identity.." in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 40-50 recite in their preamble " a method of merchandise ordering and order fulfillment..". However, no limitation recite a method step of order fulfillment. The claims merely interact to customers to assemble a customer order.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 40, 41, 46-50 and 57 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shelton (US Pat.,345,501).

Claim 40: Shelton teaches a method of merchandise ordering and fulfillment comprising: providing an order processing system comprising a central station (central office CO, in Fig. 1) interfaced to a telephone communication network (col. 4 L 38-51) so as be accessible to customer by telephone (telephone station 12) for creation of a merchandise order (refer to col. 5 L 5- 18);

assembling a customer order for fulfillment, including the steps of:

requesting from a customer a product identification item and quantity of the product item to be added to the product order (col. 2 L 17-22, col. 5 L 5-9 and col. 6 L 34-45);

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receiving the product identification and a requested product quantity from a customer (col. 2 L 17-22, col. 5 L 5-9 and col. 6 L 34-45);

confirming the identity and quantity of the product item to be included in the merchandise order (col. 6 L 56-59).

Claim 41: reciting to the customer a product description and a product price.. inherent in step of confirming as discussed above since the information pertain to the order being processed (col. 6 L 52-59).

Claims 46-48, 50: recites various elements of commonly known procedures practiced in order fulfillment. Such procedures are required steps in order to ensure accuracy of the customer order (predetermined limit quantity..claim 46), merchandise order transfer characteristics for effecting transfer to customer of the product items of the merchandise order .. as recited in claim 19 (delivery options), confirming the identity and quantity of the product item as recited in claim 20 (..confirmation message..Shelton col. 6 L 56-59 and col. 5 L 19-27).

Claims 49: said system further comprises a store station linked to said central station for receiving the merchandise order from said central station, said store station including a portable station movable by a user about a product storage space, and additionally comprising the step of transmitting a record of merchandise order to a store station for requesting payment for the merchandise order (Figure 1, central office (CO) at 10, connected to vendor site 18 having a host computer 30, Fig. 4(b), col. 6 L 38-45).

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Claim 50: assembling step includes determining whether the product identification entered by the customer is a valid product identification (col. 5 L 5 -9, step 46, confirming the category selected..).

Claim 57: transmitting a record of the merchandise order to a store station for requesting payment for the merchandise order (col. 6 L 38-45, customer orders received at the adjunct 22 (step 80) and are processed at vendor host (step 82)).

All other limitations of claim 57 are analyzed as in claim 40.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 16-20, 22, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Shelton (US Pat. 5,345,501) and further in view of Ross (US Pat. 5,720,157).

Claim 16: Shelton teaches a method of merchandise ordering and fulfillment comprising: providing an order processing system comprising a central station (central office CO, in Fig. 1) interfaced to customers to a telephone network (col. 4 L 38-51) so as be accessible to customer by telephone (telephone station 12) for creation of a merchandise order (refer to col. 5 L 5- 18), said system further comprising a store station linked to the central station for receiving said merchandise order (vendor site 18, Host Computer 30) from said central station (CO), the

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store station including a portable station movable by a user about a product storage space (inherent to any store station);

assembling a customer order for fulfillment, including the step of requesting identification of product items to be added to the product order and quantity of identified product item (col. 2 L 17-22, col. 5 L 5-9 and col. 6 L 34-45).

Shelton fails to teach the recited fulfilling steps. (It is contended that these steps are basic and inherent steps for completing any fulfillment process as discussed in background of the Invention by Ross) In the same filed of endeavor, however, Ross teaches a method of merchandise ordering and fulfillment (abstract) comprising:

assembling a customer order for fulfillment including the identification of product items ...and the quantity of each identified product item (step for assembling a customer order for fulfillment, including the step of requesting identification of product item (col. 1 L 14-27);

fulfilling the merchandise order from the product storage space including:

compiling a product listing of the ...orders to be assembled in the product storage space (..a list of SKUs or line items...col. 1 L 14-27);

identifying the product locations in the product storage space of each of the product items on said listing. (The list specifies storage location. col. 1 L 14-27);

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to combine the assembling and fulfilling steps including compiling a product list of ...merchandise orders as disclosed by Ross and in the order processing system disclosed by

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Shelton. Motivation for such a combination is obviously more efficient, accurate and economical method to fulfill orders received via the telecommunication network.

Claims 18-20 recite various elements of commonly known procedures practiced in order fulfillment. Such procedures are required steps in order to ensure accuracy of the customer order (predetermined limit quantity..claim 18), merchandise order transfer characteristics for effecting transfer to customer of the product items of the merchandise order .. as recited in claim 19 (delivery options), confirming the identity and quantity of the product item as recited in claim 20 (..confirmation message..Shelton col. 6 L 56-59 and col. 5 L 19-27).

Claim 22 and 17: determining if the customer account has an unfulfilled merchandise order ..(Shelton col. 3 L 1-11, ..customer orders unfilled...).

Claims 24 and 25: requesting and recording a payment method... and transmitting a record of merchandise order station for requesting payment..(Shelton Fig.1, Col. 4 L 38-51, ..transactions to be carried out between the vendor and the customer..).

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shelton (US Pat. 5,345,501) in view of and further in view of Ross (US Pat. 5,720,157) and further in view of Barrus et al. (US 5,465,291).

Claims 23: Shelton or Ross references fail to teach reciting a listing of any special offer product items. In the same filed of endeavor, however, Barrus teaches a method of merchandise ordering and order fulfillment comprising:

reciting a listing of any special offer product items (col. 13 L 32-50).

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It would have been obvious to one of ordinary skill in the art at the time to include recitation of special offers as recited in the Shelton method as disclosed by Barrus method because it would enable the customer to take advantage of any special merchandise offers.

9. Claims 42-45 and 51-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shelton (US Pat. 5,345,501) as applied to claim 40 above and further in view of article titled "Ordering Instructions for Price List" (p. 6-7), (ordering).

Regarding claims 42 and 43 Shelton fails to teach limitations of unfulfilled merchandise order as recited in claims 42 and 43. However, in the same field of endeavor, the ordering article teaches a method of merchandise ordering and order fulfillment (p. 6 and 7) comprising: determining if the customer has an unfulfilled merchandise order by checking an unfulfilled merchandise orders database and if so inquiring whether the customer desires a listing of the product items in the unfulfilled merchandise order....reciting a listing of product items of the unfulfilled merchandise order (p. 6 "IVR Order Inquiry- Main Menu option 4"). It would have been obvious to one of ordinary skill in the art at the time of the claimed inventions to implement the recited features of unfulfilled merchandise order because it would enable the customer to inquire about ^{and} track ^{merchandise} prior orders.

Claims 44 and 45: merchandise order transfer characteristics of the unfulfilled merchandise order and inquiring whether the unfulfilled merchandise order is to be modified are inherent to such a method as Shelton and Ordering discussed in above paragraphs.

Claim 51: Shelton teaches a merchandise ordering and fulfillment comprising:

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providing an order processing system comprising a central station interfaced to a telephone communication network so as to be accessible to customers by a telephone for creation of a merchandise order (Fig. 1, col. 3 L 54-65);

assembling a customer order for fulfillment including the step of:

requesting from a customer a product identification..and a quantity of the product item to be added to the merchandise order (verbal prompt..step 46, col. 5 L 5-9);

receiving a requested product identification and a requested quantity from a customer (inherent because confirmation of the order is recited in line 15-17);

confirming the identity and quantity of the product item to be included in the merchandise order (col. 5 L 15-17).

Shelton fails to teach limitations of unfulfilled merchandise order as recited in claim 51. However, in the same field of endeavor, the ordering article teaches a method of merchandise ordering and order fulfillment (p. 6 and 7) comprising: determining if the customer has an unfulfilled merchandise order by checking an unfulfilled merchandise orders database and if so inquiring whether the customer desires a listing of the product items in the unfulfilled merchandise order....reciting a listing of product items of the unfulfilled merchandise order (p. 6 "TVR Order Inquiry- Main Menu option 4"). It would have been obvious to one of ordinary skill in the art at the time of the claimed inventions to implement the recited features of unfulfilled merchandise order because it would enable the customer to inquire about track prior orders.

Claims 52 and 53 are analyzed as in claims 44 and 45 as above.

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Claim 54: Shelton fails to teach that the assembling step comprises comparing the requested product quantity of a product item in a merchandise order to a predetermined quantity established for said product item as claimed. In the same field of endeavor, however, Barrus teaches a method of merchandise ordering and order fulfillment comprising assembling a merchandise order wherein the requested product quantity in a merchandise order is compared to a predetermined limit and if the requested quantity exceeds the predetermined quantity and confirmation are requested from the customer as recited (col. 12 L 60- col. 13 L 20). It would have been obvious to one of ordinary skill of art at the time of the invention to implement this step because it would ensure that the accuracy of the entered order information and that the customer does not mistakenly order more quantity of an item than intended.

All other limitations of claim 54 are analyzed as in claim 51.

Claim 55: Shelton fails to teach inquiring whether the customer wishes to hear a recitation of product items on which there is a special offer as recited. In the same field of endeavor, however, Barrus teaches recitation of product items on which there is a special offer (Barrus, col. 13 L 32-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide recitation of the product items on which there is a special offers as claimed because it would enable the customer to take advantage of low price items and special items (Barrus, col. 13 L 30-50).

All other limitations of claim 55 are analyzed as in claim 51.

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Claim 56: Shelton fails to teach inquiring whether the customer wishes to hear a recitation of product items on which there is a special offer as recited. In the same field of endeavor, however, Barrus teaches recitation of product items on which there is a special offer (Barrus, col. 13 L 32-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide recitation of the product items on which there is a special offers as claimed because it would enable the customer to take advantage of low price items and special items (Barrus, col. 13 L 30-50).

All other limitations of claim 56 are analyzed as in claim 51.

10. Claims 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shelton (US Pat. 5,345,501) and further in view of Barrus et al. (US 5,465,291).

Regarding claim 46: Shelton fails to teach that the assembling step comprises comparing the requested product quantity of a product item in a merchandise order to a predetermined quantity established for said product item as claimed. In the same filed of endeavor, however, Barrus teaches a method of merchandise ordering and order fulfillment comprising assembling a merchandise order wherein the requested product quantity in a merchandise order id compared to a predetermined limit and if the requested quantity exceeds the predetermined quantity and confirmation are requested from the customer as recited (col. 12 L 60- col. 13 L 20). It would have been obvious to one of ordinary skill of art at the time of the invention to implement this step because it would ensure that the accuracy of the entered order information and that the customer does not mistakenly order more quantity of an item than intended.

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All other limitations of claim 46 are analyzed as in claim 40.

Claim 47: Shelton fails to teach selecting the merchandise order transfer characteristics for effecting the transfer to the customer of the product items of the merchandise order as recited. In the same field of endeavor, however, Barrus teaches selecting the merchandise order transfer characteristics for effecting transfer of the product items of the merchandise order, including choosing between the options as recited (Barrus, col. 14 L 21-45). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide selection of the merchandise order transfer characteristics as recited because it would provide convenience to the customer for receiving the delivery of the ordered merchandise.

All other limitations of claim 47 are analyzed as in claim 40.

Claim 48: Shelton fails to teach inquiring whether the customer wishes to hear a recitation of product items on which there is a special offer as recited. In the same field of endeavor, however, Barrus teaches recitation of product items on which there is a special offer (Barrus, col. 13 L 32-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide recitation of the product items on which there is a special offers as claimed because it would enable the customer to take advantage of low price items and special items (Barrus, col. 13 L 30-50).

All other limitations of claim 48 are analyzed as in claim 40.

Allowable Subject Matter

11. Claims 1-15, 26, 27 and 31-39 are allowed.

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12. Claims 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1065.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5397.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

JNP 09/08/01



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100